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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,099	03/03/2004	Alistair Kenneth Clement Scott	10031368-1	4110

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL 429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

NGUYEN, HANH N

ART UNIT	PAPER NUMBER
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2616

MAIL DATE	DELIVERY MODE
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12/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/792,099

Applicant(s)

SCOTT ET AL.

Examiner

Hanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Application filed on 3/3/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/10/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

Claims 1, 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A software code segment" refers to program instructions while the claim as introduced in the preamble begins with "A system..." which is an apparatus claim. It is unclear whether this is an apparatus claim or a method claim because the claimed limitations include user information characterized by different protocols and mixed with the program instructions. Applicant is required to amend the claim properly.

Information Disclosure Statement

The information disclosure statement filed 9/1/06 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the serial number (10/857,306) typed in form 1449 is incorrect. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9, 17 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It appears that the claimed "components" on line 11 is not disclosed in the specification. Further, it would have made sense if "components" is "information" identifying the first protocol and the second protocol.

Examiner assumes the "components" as "information"

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 16 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 16 and 24 are objected to because of the following informalities: it is not clear in the claims what communication protocol is considered as "non-standard communication protocol". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 9, 17 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 22 of U.S. Patent No. 7,245,609B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Patent refers to correlating first signaling information from a packet network and second signaling information from a circuit network; wherein the instant application refers to correlating a first call portion associated with the first communication protocol and a second call portion associated with second communication protocol.

It is a well-known skill in the instant application that the first call portion associated with the first communication protocol can be the MGCP signaling information associated with IP network; and the second call portion associated with second communication protocol can be SS7 signaling information associated with PSTN network. Therefore, it would have been obvious to one skilled in the art that the first communication protocol in the instant application can be circuit switch network such as

PSTN network; and the second communication protocol can be the packet network such as IP network.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-25 are rejected under 35 USC 102(e) as being anticipated by Parham et al. (US Pat. 6,839,342 B1).

In claims 1, 9, 17 and 25, It is noted that Examiner assumes the “components” as “information” identifying /relating to the first protocol and the second protocol.

Parham et al. discloses a system for correlating and displaying dissimilar communication protocol identifiers in real time, comprising:
user communication information carried on a network, where the user communication

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information is characterized by at least two dissimilar communication protocols (see fig.2, col.3, lines 20-20-40 and lines 64 to col.4, line 5; voice signals transmission in telecommunication network 20; the voice signals are carried from PSTN 12 via IP network 30); a first communication protocol (see fig.2; PSTN 12); a second communication protocol (see fig.2, IP network 30); and a software code segment configured to detect correlation data identifying a first call portion associated with the first communication protocol(see fig.2, col.3, lines 27-32; gateway 18 receives voice signals from PSTN 12), and configured to detect correlation data identifying a second call portion associated with the second communication protocol (see fig.2, col.3, line 64 to col.4, line 5; gateway 18 receives RTP packets from IP network 30), where the correlation data comprises components relating to the first communication protocol (see fig.2, col.3, lines 32-40; the voice signals is transmitted with signaling information SS7 from SS7 network 24) and the second communication protocol (see col.3, line 64 to col.4, line 5; receiving voice RTP packets and signaling information from IAD 20 via IP network 30), and wherein the correlation data is detected in real time (see col.3, lines 28-32; and line 64 to col.4, line 5; the voice signals is converted to RTP packets during transmission between PSTN 12 and IP network 30).

In claims 2, 10 and 18, Parham et al. discloses the correlation data allows the first call portion (voice from PSTN 12) call and the second call portion (RTP packets from IP network 30) to be displayed to a user in real-time in a call flow record (see col.3, lines 28-32 and fig.2; converted in real-time).

In claims 3, 11 and 19, Parham et al. discloses the correlation data relates to a signaling protocol (SS7 signalling) associated with the first communication protocol (PSTN 12) and the second communication protocol (IP network 30). See fig.2 and col.2, lines 47-55.

In claims 4,12 and 20, Parham et al. discloses the correlation data is supplied to an analysis device (gateway 18) that is coupled to the communication network (communication network 20 in fig.2), and wherein the correlation data is supplied by a customer provided communication device (from customer premises 22 as shown in fig.2). See col.3, lines 20-30.

In claims 5, 13 and 21, Parham et al. discloses the correlation data comprises information relating to multiple telephone calls that span the dissimilar communication protocols (see fig.2, voice traffic transmissions between customer premises 22 via IP network 30, PSTN 12). See col.3, lines 20-42.

In claims 6, 14 and 22, Parham et al. discloses the correlation data identifies dissimilar signaling protocols (See col.2, lines 30-50, SS7 signalling and MGCP) , and wherein a first signaling protocol complies with SS7 ISUP (the SS7 signalling is associated with TDM 12).

In claims 7, 15 and 23, Parham et al. discloses the correlation data identifies dissimilar signaling protocols related to a telephone call, and wherein the second communication protocol complies with media gateway control protocol (MGCP) (see col.2, lines 38-47; at gateway 18, media gateway in a form of MGCP is received and processed to provide signaling information).

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In claims 8, 16 and 24, Parham et al. discloses the customer provided communication device is a switch (class5 softswitch 26 as shown in fig.2), and wherein the second communication protocol is a non-standard communication protocol (IP network 30 shown in fig.2).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kumar et al. (US pat. 7,085,279 B1);

Pershan (US pat. 6,865,266 B1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Nguyen whose telephone number is 571 272 3092. The examiner can normally be reached on Monday-Thursday from 8:30 to 4:30. The examiner can also be reached on alternate

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached on 571 272 2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Hanh Nguyen

A handwritten signature in black ink, appearing to read 'Hanh Nguyen', with a stylized, cursive script.

**HANH NGUYEN
PRIMARY EXAMINER**